

### **REMARKS**

The Office Action dated May 23, 2008, has been received and carefully noted. The above amendments to the specification and claims, and the following remarks, are submitted as a full and complete response thereto.

By this Response, claims 10-21 have been amended to more particularly point out and distinctly claim the subject matter of the present invention. No new matter has been added. Claims 1-9 were previously withdrawn in Applicants' Response filed on February 11, 2008. Support for the above amendments is provided in the Specification at least on page 19, line 10, to page 20, line 21. Accordingly, claims 10-21 are currently pending in the application, of which claim 10 is the only independent claim.

In view of the above amendments and the following remarks, Applicants respectfully request reconsideration and timely withdrawal of the pending rejections to the claims for the reasons discussed below.

#### ***Information Disclosure Statement***

The Office Action indicated that the listing of references on pages 7-9 of the Specification is not a proper information disclosure statement. Referencing 37 C.F.R. §1.98(b) and MPEP § 609.04(a), the Office Action indicated that a list of all patents, publications, or other information submitted for consideration by the Office may not be incorporated through the Specification, but must be submitted in a separate paper. The Office Action further indicated that unless the references were cited by the Examiner on

PTO-892, the references have not been considered. Applicants respectfully traverse the objection to the Information Disclosure Statement.

Applicants respectfully submit that at least all of the references listed on pages 7-9 of the Specification were presented in an Information Disclosure Statement, listed on a PTO-1449 form, filed on August 29, 2006.

Further, the Office Action indicated that the citation of document AA, U.S. Plant Patent 13073, listed on the Information Disclosure Statement filed on August 29, 2006, was corrected by the Examiner to reflect the publication date of October 15, 2002. Applicants thank the Examiner for the courtesies extended regarding this minor informality.

Further, the Office Action indicated that the references crossed out on the Information Disclosure Statement filed on August 29, 2006, were not considered by the Examiner because they are not provided in the English language, and Applicants failed to provide a translation or concise explanation of the reference, as required by 37 C.F.R. §1.98(a)(3)(i).

Accordingly, Applicants submit herewith an Information Disclosure Statement presenting English translations of the references crossed out on the Information Disclosure Statement filed on August 29, 2006. Applicants respectfully request consideration of the references listed on the Information Disclosure Statement attached herewith.

### *Specification*

The Office Action objected to the disclosure of the Specification because of minor informalities. Specifically, the Office Action indicated that reference to U.S. Patent 13073, listed in the Specification at page 7, line 21, and page 8, line 16, is incorrect and should refer to U.S. PP 13073.

Accordingly, Applicants have amended the disclosure of the Specification at page 7, line 21, and page 8, line 16, to correct the minor informalities.

Therefore, Applicants respectfully request withdrawal of the objection to the disclosure of the Specification, and respectfully submit that the Specification is now in condition for allowance.

Further, the Specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Office Action alleged that the limitation, “genotype  $H^X H^X$  Pg/pg Cy/cy/Dp/dp” lacks proper antecedent basis. Further, the Office Action alleged that it is unclear where “ $H^X H^X$ ” is defined in the Specification.

Accordingly, claim 20 has been amended to remove the limitation, “ $H^X H^X$  Pg/pg Cy/cy/Dp/dp,” rendering the insufficient antecedent basis objection moot.

Therefore, Applicants respectfully request withdrawal of the objections to the disclosure of the Specification, and respectfully submit that the Specification is now in condition for issuance.

### ***Claim Objections***

The Office Action objected to claims 20 and 21 because of minor informalities.

Accordingly, Applicants have amended the dependency of claims 20-21, rendering the objection to claims 20 and 21 moot.

Therefore, Applicants respectfully request withdrawal of the objections of claims 20-21, and respectfully submit that claims 20-21 are now in condition for allowance.

### ***Claim Rejections under 35 U.S.C. §112, Second Paragraph***

The Office Action rejected claims 11 and 15-20 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Office Action indicated that the limitation, “preferably” recited in claim 11, line 2, renders the claim indefinite because it is unclear if the “gene” is required in the invention or not. Claims 15, 17, and 19 depend from claim 11; and therefore, are also indicated as allegedly being indefinite.

Accordingly, Applicants have amended claim 11 to remove the limitation, “preferably” from the claim recitation.

Further, the Office Action indicated that claim 20 is indefinite because it is unclear where “H<sup>X</sup>H<sup>X</sup>” is defined in the Specification.

Accordingly, claim 20 has been amended to remove the limitation, “H<sup>x</sup>H<sup>x</sup> Pg/pg Cy/cy/Dp/dp,” rendering the rejection of claim 20 under 35 U.S.C. §112, second paragraph, moot.

Further, the Office Action indicated that the term “heat resistant” recited in claims 16-19 is a relative term which renders the claim indefinite. The Office Action alleged that the Specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Further, the Office Action alleged that Applicants’ definition of “heat resistant” on page 18 of the Specification, “high temperature and high humidity” is relative and does not provide a standard for ascertaining the requisite degree of the limitation. Applicants respectfully traverse these rejections for at least the following reasons.

As described in the two attached references, Meadowbrook Nursery: We-Du Natives and Dave’s Garden: Plantfiles: Hybrid Deciduous Azalea Rhododendron x ‘Aromi Sunny Side Up,’ one of ordinary skill in the art would reasonably understand the advantage of a heat resistant characteristic of azaleas regarding the azalea’s ability to “grow even under high temperatures and high humidity” as described in the Specification on page 18, lines 10-20. Therefore, the Specification sufficiently describes the term “heat resistant” to one of ordinary skill in the art at the time the invention was made

Therefore, Applicants respectfully request withdrawal of the rejection of claims 11 and 15-20 under 35 U.S.C. §112, second paragraph, and respectfully submit that claim 11 and 15-20 are now in condition for allowance.

***Claim Rejections under 35 U.S.C. §112, First Paragraph***

The Office Action rejected claim 20 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Office Action alleged that the claims contain subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office Action alleged that the Specification fails to describe the limitation, “H<sup>X</sup>H<sup>X</sup>.” Further, the Office Action alleged that the limitation, “Pg/pg Cy/cy/Dp/dp” implies an inheritance produced by a cross of plants having the genotypes PgCyDp x pgcydp, yet the Specification discloses that Pg and Dp pigments are non co-existing (See Specification page 17, line 11).

Accordingly, claim 20 has been amended to remove the limitation, “H<sup>X</sup>H<sup>X</sup> Pg/pg Cy/cy/Dp/dp,” rendering the rejection of claim 20 under 35 U.S.C. §112, second paragraph, moot.

Therefore, Applicants respectfully request withdrawal of the rejection of claim 20 under 35 U.S.C. §112, first paragraph, and respectfully submit that claim 20 is now in condition for allowance.

***Claim Rejections under 35 U.S.C. §102(b)***

The Office Action rejected claims 10-12, 14-19, and 21 under 35 U.S.C. §102(b) as allegedly anticipated by Lee (U.S. Patent Plant No. 10,438) (“Lee”). The Office Action alleged that Lee discloses or suggests every feature recited in claims 10-12, 14-19, and 21. Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the teachings of Lee.

Claim 10, upon which claims 11-21 depend, recites a method. The method includes introducing a genotype from an azalea comprising an ever-flowering property into a deciduous, one season flowering azalea to breed an ever-flowering azalea.

As will be discussed below, Lee fails to disclose or suggest every feature recited in claims 10-12, 14-19, and 21, and therefore fails to provide the features of the claims discussed above.

Lee is directed to an evergreen azalea of the genus *Rhododendron* and a member of the *Ericaceae* family. The new azalea is referred to as ‘Conlea,’ which was discovered by Robert Edward Lee in October 1985 in Independence, La. ‘Conlea’ originated from a planned cross hybridization between two selected breeding lines in a controlled breeding program in Independence, La. The value of this new cultivar lies in its unique blooming period, bloom color, bloom form, and growth habit (Lee, Background of the Invention).

Applicants respectfully submit that Lee fails to disclose or suggest every feature recited in claim 10. In particular, Lee fails to disclose or suggest, at least, “introducing a genotype from an azalea comprising an ever-flowering property into a deciduous, one

season flowering azalea to breed an ever-flowering azalea,” as recited in claim 10 (emphasis added).

Rather, Lee discloses a planned cross hybridization between two selected breeding lines in a controlled breeding program. The female, or seed parent, of ‘Conlea’ is the Azalea ‘Double Beauty’ which is a recognized *evergreen*, one-season flowering azalea. The male, or pollen parent, is *Rhododendron oldhamii* ‘Fourth of July’ which is an evergreen, ever-flowering azalea (Lee, columns 1-3).

Accordingly, Lee fails to disclose or suggest that the one season flowering azalea is *deciduous*.

Accordingly, Lee fails to disclose or suggest every feature recited in claim 10. Claims 11-21 depend from claim 10. Accordingly, claims 11-21 should be allowable for at least their dependency upon an allowable base claim, and for the specific limitations recited therein.

Therefore, Applicants respectfully request withdrawal of the rejections of claims 10-12, 14-19, and 21 under 35 U.S.C. §102(b) and respectfully submit that claim 10, and the claims that depend therefrom, are now in condition for allowance.

***Claim Rejections under 35 U.S.C. §103(a)***

The Office Action rejected claim 13 under 35 U.S.C. §103(a) as being allegedly unpatentable over Lee in view of Tamura, *et al.* (April 1989, “Hirado Tsutsuji no Saibai to Yurai,” Kurume no Tsutsuji, Ashi Shobo, pp. 153-162, pp. 157-158 in English)



(“Tamura”). Applicants respectfully submit that the claims recite subject matter that is neither disclosed nor suggested in the combination of Lee and Tamura.

Lee was discussed above. Tamura is directed to Hirado azaleas (Tamura, pages 153-162).

As previously noted above, Lee fails to disclose or suggest each and every element recited in claim 10. Tamura fails to cure the deficiencies of Lee. Specifically, Tamura fails to disclose or suggest, at least, “introducing a genotype comprising an ever-flowering property into a deciduous one season flowering azalea to breed an ever-flowering azalea,” as recited in claim 10 (emphasis added).

Furthermore, contrary to the Office Action’s conclusions, one of ordinary skill in the art would not have found it an obvious design choice to combine the teachings of Lee with the teachings of Tamura to disclose or suggest the features recited in claim 13. The Office Action alleged that it would have been a design choice to select a specific type of azalea to use in a breeding method based on obvious characteristics such as growth habit and flower characteristics, in addition to the ever-flowering property taught by Lee (See Office Action on page 7).

It is improper to base a rejection of the claimed features being merely a design choice. See *In re Garrett*, 1986 Pat. App. LEXIS 8 (Bd. Pat. App. 1986), where the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences (“Board”) specifically stated: “the examiner has not presented any line of reasoning as to why the artisan would have been motivated to so modify the...structure, and we know of none.

The examiner's assertion...that the proposed modification would have been "an obvious matter of engineering design choice well within the level of skill of one of ordinary skill in the art" is a conclusion, rather than a reason." Similar discussions can be seen in *In re Chu*, 36 USPQ2d 1089 (Fed. Cir. 1985). The Board further states that "the mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984) (See MPEP §2144.04(IV)(C)).

Furthermore, the teachings of Lee specifically disclose that Lee purposely planned a cross hybridization between two selected breeding lines in a controlled breeding program in Independence, La. The value of this new cultivar lies in its unique blooming period, bloom color, bloom form, and growth habit (Lee, Background of the Invention). Therefore, Lee purposely chose the Azalea 'Double Beauty' and the *Rhododendron oldhamii* 'Fourth of July' for his planned cross hybridization; and therefore, the teachings of Lee and the teachings of Tamura provide no motivation to substitute the Azalea 'Double Beauty' with a Hiroda azalea. The Office Action failed to provide a proper motivation that would have motivated one of ordinary skill in the art to modify the teachings of Lee with the teachings of Tamura keeping with the intended purpose and teachings of Lee.

Claim 13 depends from claim 10. Accordingly, claim 13 should be allowable for at least its dependency upon an allowable base claim, and for the specific limitations recited therein.

Therefore, Applicants respectfully request withdrawal of the rejections of claim 13 under 35 U.S.C. §103(a) and respectfully submit that claim 10, and the claims that depend therefrom, are now in condition for allowance.


### **CONCLUSION**

In conclusion, Applicants respectfully submit that Lee and Tamura, alone or in combination, fail to disclose or suggest every feature recited in claims 10-21. The distinctions previously noted are more than sufficient to render the claimed invention unanticipated and non-obvious. It is therefore respectfully requested that all of claims 10-21 be allowed, and this present application be passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Information Disclosure Statement/Form PTO-1449  
References (13)  
Check No. 019432